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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,325	12/08/2003	Jerome Skuba	Skuba-P1-03	2418
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PETER K. TRZYNA, ESQ.			PALO, FRANCIS T	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/730,325	Applicant(s) SKUBA, JEROME	
	Examiner Francis T. Palo	Art Unit 3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s)* _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments, see Pre-Appeal Brief, filed 6/8/07, with respect to claims 1, 2 and 21 have been fully considered but they are not persuasive. That is, in view of the guidance provided by the Supreme Court in *KSR*, the examiner has elected to better articulate his reasons or rationale for rejecting the claims of the instant invention, in consideration that a person of ordinary skill in the art would exercise ordinary creativity, common sense and logic.

Specifically, applicant's amendment to overcome the teaching of Kawamoto '690 by reciting "so that the roots can knit essentially unimpeded with earth below the piece at the user's garden location", and applicant's arguments regarding the forming of a corporate logo are redressed below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Currently amended independent claims 1 and 2 recite; "so that the roots can knit essentially unimpeded with earth below the piece".

It is unclear what applicant intends by "essentially unimpeded", as applicant teaches three-dimensional webbing or netting defining spaces (4) prescribed by corners (4), the webbing further including a three-dimensional net (12) oscillating through the webbing and further having a lower sheet or mat (14) matrix and a bottom net (16) as depicted in the instant application figures.

The examiner respectfully submits that the three-dimensional webbing of the present invention and lower sheet and net structures impedes the knitting of the roots therein with the ground below and certainly promotes entanglement of those roots growing therein the webbing thus forming the mat of roots. Further, while the roots contained within the mat of the instant invention can knit with earth below, it is submitted that they cannot knit essentially unimpeded as claimed, and such language should be removed from the claims as the invention is not enabling for such limitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-21 are rejected under 35 U.S.C. 102(a),
as anticipated by or, in the alternative, under 35 U.S.C. 103(a),
as obvious over **Kawamoto** (JP 10313690A) 1998;
Priority Date (JP0127110) 5/1997.

Regarding currently amended **claim-1**:

As submitted in the previous office action, **Kawamoto '690** teaches a **garden creating method** of successively arranged multiple standardized garden items ('690 claim-1), which is read as **forming a design and implementing the design**, as claimed.

Kawamoto further depicts in the figures, **forming pieces** (figures 4, 5, 11-18 and 22) corresponding to a portion of the design (figures 3, 6, 7), as claimed; specifically, a grass piece (figure-5), plants (figure-22) and stone (figure-4) among others, are depicted as claimed.

Kawamoto also teaches [0045] **garden items** (21-24 and 30) are **formed, packaged and shipped** (as in transported to a user's garden location) and [0006] that the size and shape of the garden items are not limited to parallelepiped shape, and any in the size and shape that **workers can carry around** can be used.

Note; that a "piece" as broadly claimed, has been afforded the broadest possible interpretation, as reading on the "standardized garden items (containers)" as taught by Kawamoto, and that by the disclosure and figures of Kawamoto, a method of forming a garden by forming a design and implementing the design by forming a piece corresponding to a portion of the design by growing roots in the piece at, at least one grower location, is evident from the figures and/or are disclosed by Kawamoto.

As regards the amended language directed to the roots knitting essentially unimpeded with the earth below as claimed, and in consideration of the **35 USC § 112** rejection above; Kawamoto teaches [0008] that as depicted in figures 17 and 18, frame (2a) is filled with soil (2b) and lawn (2c) is planted over this arrangement, and [0032] that roots of said lawn (2c) are strongly rooted in the soil.

In consideration of applicant's comments, the argument is well taken that since the "piece" of Kawamoto includes the containment means, as such, the roots are unable to knit essentially unimpeded with the earth below the piece.

The examiner responds that Kawamoto depicts in figure-19, containment means provided with irrigation holes (25c), and it is well known to most anyone ever exposed to a plant in a container having drainage holes, roots do find their way to and through said holes, and where the container is on the ground, those escaped roots grow into the ground below the container.

Therefore, in consideration of the **35 USC § 112** rejection as discussed above, Kawamoto is capable of the amended claim language, as best can be understood, as the roots of the plant material growing in the container of Kawamoto are capable of finding their way to and through the drainage holes (25c) depicted in figure-19 to root "essentially unimpeded" with earth below the piece, which comprises the container, growth medium and plant(s) growing therein, as claimed.

Regarding currently amended independent **claim-2**:

The discussion above regarding claim-1 is relied upon.

The instant claim differs from claim-1 in that applicant is now claiming a "**mat**" of roots instead of a "**piece**" as recited in claim-1.

The examiner respectfully submits that the rejection above as regards the "piece" is applicable to the "mat" as now claimed; as Kawamoto teaches as depicted in his figures a sod mat (not seed) placed on top of the soil within the container, and as the container is provided with drainage holes, the roots from the mat would eventually find their way to and through the drainage holes, which would be readable thereon the amended claim language.

Regarding **claim-3**:

The discussion above regarding claim-2 is relied upon.

Kawamoto teaches "lawn" (grasses as claimed) among others, as discussed above in the independent claims.

Regarding **claims 4 and 5**:

The discussion above regarding claim-3 is relied upon.

Second and third members as claimed, are readily apparent from the figures of Kawamoto; specifically in figures 3, 6, 7, and as discussed above in claim-1.

Regarding **claims 6-15, 18 and 19:**

The discussions above regarding claims 1 and 3 are relied upon.

Kawamoto teaches lawn [0007], moss [0008] and that the garden items should not be limited to only those items that are listed [0007]; as there are many species of grasses (both ornamental and lawn species) and likewise moss, Kawamoto thus encompasses the eight mat members as claimed in the instant claims.

Regarding amended claim-20:

The discussions above regarding claims 1 and 2 are relied upon as encompassing the limitations of the instant claim.

Regarding repeating **claims 16 and 17:**

The discussions above regarding claims 1 and 2 are relied upon.

Kawamoto teaches in his system that a **garden with an overall uniformity** and a beautiful view can be created in a location where the garden should be created, including the rooftop and balcony of a building **or within a lot** (USPTO translation; [0053]);

it is respectfully submitted that the garden of Kawamoto encompasses and contemplates a corporate logo garden as claimed, as in turning to the instant disclosure for guidance on the meaning of a corporate logo, it is noted on page-8 of the instant specification that applicant recites, "it is an additional object to provide a system for commercially producing a landscape or garden design, such as a corporate logo pattern".

It is respectfully maintained that Kawamoto anticipates or contemplates a corporate logo garden as claimed, as that form of garden design is readable on a garden with an overall uniformity and a beautiful view as taught by Kawamoto and as claimed, and that rearranging or planning a specific pattern or design such as a logo as broadly claimed is within the scope of the utility and capability of the Kawamoto system.

Regarding independent **claim-21**:

The revised discussions above regarding claims 1, 2, 16 and 17 are relied upon as teaching the limitations of the new independent claim.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ripley '834 like Kawamoto teaches the well-known aspects of forming a garden and implementing the design and further teaches modules and layouts to accommodate various plant species and ornaments as claimed in the instant invention.

Molnar '290 teaches mats for flowers among others that could be incorporated into the systems of Ripley and Kawamoto.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 571-272-6907. The examiner can normally be reached on M-Tu.,Th.-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Francis T. Palo

Francis T. Palo
Primary Examiner
Art Unit 3644